

may optionally comprise from 1 to 12 hetero atoms chosen from O, N, S and Si and, wherein the unit may be optionally substituted with at least one substituent;

- wherein at least one of the pair of radicals R1 with R2 and R3 with R4, together with the carbon atoms to which they are attached, may optionally form a ring chosen from a saturated ring and an unsaturated ring, the ring comprising from 5 to 6 carbon atoms in total, wherein the ring may optionally comprise at least one hetero atom chosen from O, N and S, and, wherein the ring may be optionally substituted with at least one substituent;

- wherein the radicals R2 and R3, together with the carbon atoms to which they are attached, may optionally form a ring chosen from a saturated ring and an unsaturated ring, the ring comprising from 5 to 6 carbon atoms in total, wherein the ring may optionally comprise at least one hetero atom chosen from O, N and S, and, wherein the ring may be optionally substituted with at least one substituent, and

wherein the cosmetically acceptable medium comprises at least one ingredient chosen from alcohols, surfactants, thickeners, film-forming polymers, plasticizers, fatty phases, particulate phases, water-soluble dyes, liposoluble dyes, antioxidants, fragrances, essential oils, preserving agents, lipophilic cosmetic active agents, hydrophilic cosmetic active agents, moisturizers, vitamins, fatty acids, sphingolipids, self-tanning agents, sunscreens, antifoaming agents, sequestering agents and antioxidants.

## REMARKS

### **I. STATUS OF THE CLAIMS**

Claims 1 and 3-44 are currently pending in this application. Claim 2 has been cancelled, and claims 1, 19 and 25 have been amended. Specifically, Applicants have amended independent claims 1 and 25 to recite that the claimed compositions comprise a cosmetically acceptable medium as defined in these claims. Further to the

cancellation of claim 2, Applicants have also amended claim 19 to correct its dependencies.

Applicants submit that these amendments have full Section 112 support in the specification. For example, the specification at pages 19-24 establish that Applicants explicitly considered and claimed compositions that contained a cosmetically acceptable medium. Thus, these amendments raise no issue of new matter and Applicants respectfully request their entry.

## **II. CLAIM REJECTIONS UNDER 35 U.S.C. § 102(b)**

The Examiner rejected claims 1-19 and 21-32 under 35 U.S.C. § 102(b) as being anticipated by Cheng et al. (J.Med. Chem., 1993, vol. 36, pages 4108-4112). Office Action at page 3. Applicants respectfully disagree with this rejection.

To anticipate a claimed invention, a prior art reference must describe each and every element as set forth in the claim. M.P.E.P. § 2131. Applicants' amended claims 1 and 25 recite a composition comprising a cosmetically acceptable medium comprising at least one ingredient chosen from alcohols, surfactants, thickeners, film-forming polymers, plasticizers, fatty phases, particulate phases, water-soluble dyes, liposoluble dyes, antioxidants, fragrances, essential oils, preserving agents, lipophilic cosmetic active agents, hydrophilic cosmetic active agents, moisturizers, vitamins, fatty acids, sphingolipids, self-tanning agents, sunscreens, antifoaming agents, sequestering agents and antioxidants. Cheng et al. does not describe such a cosmetically acceptable medium as defined in claims 1 and 25.

Applicants therefore respectfully submit that the standard of anticipation is not met by Cheng et al., and request that this rejection should be withdrawn.

### III. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

The Examiner rejected claims 1-44 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,940,983 ("Sartori") in view of U.S. Patent No. 3,856,026 ("Gaydos") for the reasons disclosed at page 4 of the Office Action. Applicants respectfully traverse this rejection.

While the Examiner has admitted that Sartori does not teach the elected compound, he argued that Sartori teaches 8-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione and 11-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione. Office Action at page 4 and Sartori, col. 2, lines 45 and 64, and claims 3 and 5. The Examiner argues that these compounds are positional isomers of the elected compound and therefore render the elected compound obvious. Office Action at page 4.

Applicants submit that, as a general matter, isomerism by itself should not raise a prima facie case of obviousness. See *Ex Parte Mowry*, 91 U.S.P.Q. 219, 221 (Bd. Pat. App. 1950) (rejecting the proposition that isomers in the broad sense are necessarily equivalent and holding claimed cyclohexylstyrene unobvious over prior art isohexylstyrene). Indeed, the Federal Circuit has admonished against generalizing, especially in the area of chemical structural obviousness, requiring proof in the prior art to support a proposed structural change. See *In re Grabiak*, 769 F.2d 729, 731-32, 226 U.S.P.Q. 870, 872 (Fed. Cir. 1985) (finding no prima facie obviousness where the prior art did not suggest appellants' substitution of a thioester for an ester substituent on a carboxamide compound).

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Further, Applicants respectfully direct the Examiner to *Ex parte Hogg*, 121 U.S.P.Q. 96 (Bd. Pat. App. 1958), where the Board of Patent Appeals and Interferences held that a generalized conclusion based on isomerism alone did not support a prima facie case of obviousness. In *Hogg*, the claimed cyclohexene compound differed from the prior art in that it contained a primary alcohol substituent (-CH<sub>2</sub>CH<sub>2</sub>OH) attached to the olefinic carbon of the ring. The prior art isomer of the prior art instead contained a hydroxyl (-OH) and an ethyl (-CH<sub>2</sub>CH<sub>3</sub>) attached to a single, *non*olefinic carbon of the cyclohexene ring. The Board reversed the examiner's holding of obviousness based only on the isomeric relationship of the compounds. The Board found that while the compounds constituted isomers, "fundamental structural differences exist[ed]." *Id.* at 98. It went on to state that "isomerism alone cannot negative patentability of one compound over another, since obviously the isomers must be of such relationship structurally that one would be suggestive of the other." *Id.* Applicants respectfully submit that the case of *Ex parte Hogg* is applicable to the facts of the present situation.

Sartori teaches 8-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione and 11-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione wherein the chloro group is on a different phenyl ring than the elected species compound. Sartori teaches that the chloro group may be placed at any position 8-11, i.e., "in one of the  $\alpha$ -positions," on the phenyl ring on which it is disclosed. Col. 1, lines 15-25. Sartori does not teach or suggest that the chloro group may be positioned on any other ring structure, let alone the phenyl ring of the elected species of Example 1. In fact, Sartori teaches that next to the furan is a "group of atoms needed to complete the radical of a bicyclic aromatic compound which is free of water-solubilizing groups." Col. 1, lines 24-29. Sartori does not teach or suggest that

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this "group of atoms" should include a chloro group in the 5 position of the of the phenyl ring to the right of the furan. Sartori therefore does not teach or suggest the elected species.

Gaydos does not overcome this deficiency, nor does the Examiner rely on Gaydos for this purpose. The Examiner admitted that Sartori "lacks the use of the compounds in cosmetic compositions." See Office Action dated October 1, 2002, at 4. The Examiner relied on Gaydos for teaching flock that is applied "to fingernails, toenails, eyelids, eyebrows, eyelashes, and other portions or areas of the body for cosmetic purposes." See Abstract. The Examiner argued that the disclosed flock includes polyester fibers in various colors and refers to col. 1, lines 42-56. He argued that "polyester fibers in various colors have art-recognized suitability for the intended purpose of formulating cosmetic compositions for nails, hair, eyelashes, and other areas of the body." Office Action at page 5. Finally, the Examiner argued that it would have been obvious "to have used polyester fibers dyed with the compounds of Sartori in cosmetic compositions as taught by Gaydos in order to benefit from polyester fibers in various colors with bright, strong colors of good sublimation fastness as taught by Sartori." *Id.*

It is important to note, however, that Sartori also teaches that his compounds result in yellow to orange materials which are useful as disperse dyes for polyester fibers. See col. 1, lines 42-44. In order to successfully combine this teaching with the teachings of Gaydos and thereby achieve the claimed invention, one of ordinary skill in the art must make many independent choices:

First, one must decide to use flock as a substrate in a cosmetic composition;

Second, one must decide to use a synthetic flock as opposed to a natural flock;

Third, one must decide to use polyester fibers as the synthetic flock versus nylon, rayon, or other synthetic materials;

Fourth, one must decide that the polyester flock should be dyed;

Fifth, one must decide that the color should be yellow or orange; and

Sixth, one must decide to use the 8-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione or 11-chloro-dinaphtho-(1,2-2',3')furan-7,12-dione compound as taught by Sartori.

A prima facie case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P § 2142. No motivation exists here to make each and every one of these independent choices. Moreover, even if all these choices were made, this would still not arrive at the claimed invention because, at best, positional isomers would result. As discussed above, there exists no motivation to modify this alleged positional isomer in an attempt to arrive at the claimed compound.

The Examiner has argued that the teaching of bright, strong colors is enough motivation to make all of the independent choices needed to arrive at the claimed invention. However, the Examiner has merely relied on picking and choosing disclosures from various references to make his argument and has not provided the required evidence on the record to satisfy the motivation needed to make all of the independent choices discussed above.

Applicants therefore respectfully submit that the Examiner has failed to establish a prima facie case of obviousness and request that the rejection be withdrawn.

#### IV. CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 3, 2003

By:



Mark D. Sweet  
Reg. No. 41,469

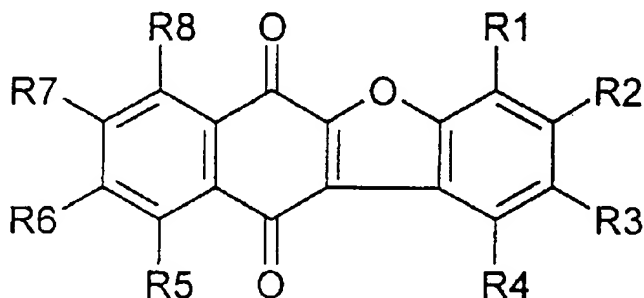
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## APPENDIX: Version With Markings To Show Changes Made

1. (Amended) A cosmetic composition comprising a cosmetically acceptable medium and at least one ingredient chosen from compounds of formula (I) and salts thereof:



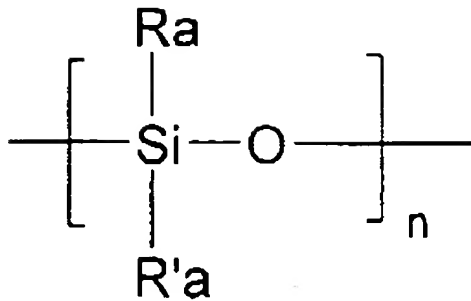
in which the radicals R1 to R8, which may be identical or different, are chosen from:

- a hydrogen atom;
- a halogen atom;
- a hydroxyl radical;
- an amino radical -NRR', wherein R and R', which may be identical or different, are each a unit chosen from a hydrogen atom and linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms;
- a nitro radical;
- an alkylamido radical -NH-CO-R'' wherein R'' is a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms;
- a ureido radical -NH-CO-NH-R''' wherein R''' is a unit chosen from a hydrogen atom and linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms;
- an alkylurethane radical of formula -O-CO-NHR''' wherein R''' is a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms;
- a dialkylsiloxane radical of formula:

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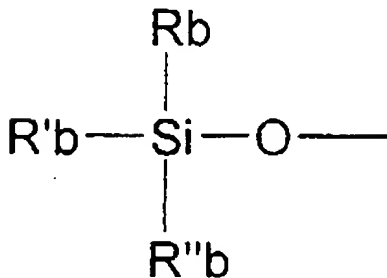
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in which

- n is an integer ranging from 1 to 12;
- Ra and R'a, which may be identical or different, are each a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms, wherein the unit may optionally comprise from 1 to 12 hetero atoms chosen from O, N, S and Si and, wherein the unit may be optionally substituted with at least one substituent;
- a trialkylsilane radical of formula:



- in which Rb, R'b and R''b, which may be identical or different, are each a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms, wherein the unit may optionally comprise from 1 to 12 hetero atoms chosen from O, N, S and Si and, wherein the unit may be optionally substituted with at least one substituent; and
- a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms, wherein the unit

may optionally comprise from 1 to 12 hetero atoms chosen from O, N, S and Si and, wherein the unit may be optionally substituted with at least one substituent;

- wherein at least one of the pair of radicals R1 with R2 and R3 with R4, together with the carbon atoms to which they are attached, may optionally form a ring chosen from a saturated ring and an unsaturated ring, the ring comprising from 5 to 6 carbon atoms in total, wherein the ring may optionally comprise at least one hetero atom chosen from O, N and S, and, wherein the ring may be optionally substituted with at least one substituent;

- wherein the radicals R2 and R3, together with the carbon atoms to which they are attached, may optionally form a ring chosen from a saturated ring and an unsaturated ring, the ring comprising from 5 to 6 carbon atoms in total, wherein the ring may optionally comprise at least one hetero atom chosen from O, N and S, and, wherein the ring may be optionally substituted with at least one substituent; and

wherein the cosmetically acceptable medium comprises at least one ingredient chosen from alcohols, surfactants, thickeners, film-forming polymers, plasticizers, fatty phases, particulate phases, water-soluble dyes, liposoluble dyes, antioxidants, fragrances, essential oils, preserving agents, lipophilic cosmetic active agents, hydrophilic cosmetic active agents, moisturizers, vitamins, fatty acids, sphingolipids, self-tanning agents, sunscreens, antifoaming agents, sequestering agents and antioxidants.

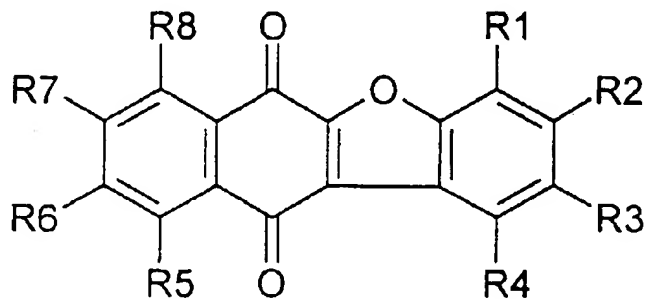
19. (Amended) The composition according to claim 12, wherein the cosmetically acceptable medium comprises a suspension, a dispersion, a solution in solvent medium which is optionally thickened, a solution in aqueous-alcoholic medium which is optionally thickened, a gelled solution; an oil-in-water emulsion; a water-in-oil emulsion; a multiple emulsion; a gel; a mousse; an emulsified gel; a dispersion of vesicles; a two-phase lotion; a multiphase lotion; a spray; a free powder; a powder compact; a cast powder; or an anhydrous paste.

25. (Amended) A make-up product for body, skin, lips or for keratin fibers, a care product for facial or body skin, an antison composition, an artificial tanning

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composition, or a hair composition comprising a cosmetically acceptable medium and at least one ingredient chosen from compounds of formula (I) and salts thereof:

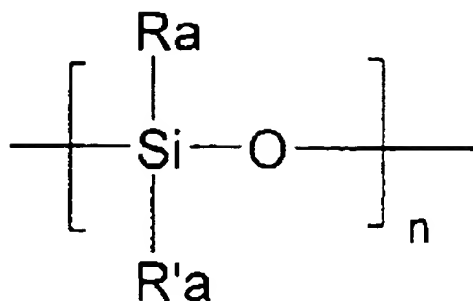


in which the radicals R1 to R8, which may be identical or different, are chosen from:

- a hydrogen atom;
- a halogen atom;
- a hydroxyl radical;
- an amino radical -NRR', wherein R and R', which may be identical or different, are each a unit chosen from a hydrogen atom and linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms;
- a nitro radical;
- an alkylamido radical -NH-CO-R'' wherein R'' is a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms;
- a ureido radical -NH-CO-NH-R''' wherein R''' is a unit chosen from a hydrogen atom and linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms;
- an alkylurethane radical of formula -O-CO-NHR'''' wherein R'''' is a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms;
- a dialkylsiloxane radical of formula:

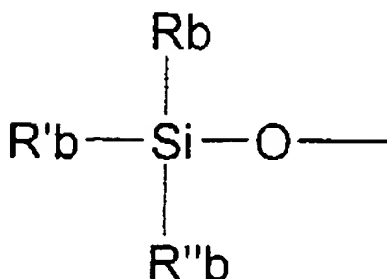
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in which

- n is an integer ranging from 1 to 12;
- Ra and R'a, which may be identical or different, are each a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms, wherein the unit may optionally comprise from 1 to 12 hetero atoms chosen from O, N, S and Si and, wherein the unit may be optionally substituted with at least one substituent;
- a trialkylsilane radical of formula:



- in which Rb, R'b and R''b, which may be identical or different, are each a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms, wherein the unit may optionally comprise from 1 to 12 hetero atoms chosen from O, N, S and Si and, wherein the unit may be optionally substituted with at least one substituent; and
- a unit chosen from linear, branched and cyclic, saturated and unsaturated hydrocarbon-based radicals comprising from 1 to 36 carbon atoms, wherein the unit

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may optionally comprise from 1 to 12 hetero atoms chosen from O, N, S and Si and, wherein the unit may be optionally substituted with at least one substituent;

- wherein at least one of the pair of radicals R1 with R2 and R3 with R4, together with the carbon atoms to which they are attached, may optionally form a ring chosen from a saturated ring and an unsaturated ring, the ring comprising from 5 to 6 carbon atoms in total, wherein the ring may optionally comprise at least one hetero atom chosen from O, N and S, and, wherein the ring may be optionally substituted with at least one substituent;

- wherein the radicals R2 and R3, together with the carbon atoms to which they are attached, may optionally form a ring chosen from a saturated ring and an unsaturated ring, the ring comprising from 5 to 6 carbon atoms in total, wherein the ring may optionally comprise at least one hetero atom chosen from O, N and S, and, wherein the ring may be optionally substituted with at least one substituent, and:-

wherein the cosmetically acceptable medium comprises at least one ingredient chosen from alcohols, surfactants, thickeners, film-forming polymers, plasticizers, fatty phases, particulate phases, water-soluble dyes, liposoluble dyes, antioxidants, fragrances, essential oils, preserving agents, lipophilic cosmetic active agents, hydrophilic cosmetic active agents, moisturizers, vitamins, fatty acids, sphingolipids, self-tanning agents, sunscreens, antifoaming agents, sequestering agents and antioxidants.